

**REMARKS**

In the present Amendment, the title has been amended to correct a typographical error. In addition, the specification has been amended to provide continuing data of the present application.

Claims 1-6 have been amended to correct typographical errors and to improve their form.

Claim 8 has been canceled. Claim 10 was canceled previously.

Claim 11 has been added. Claim 11 is supported by the specification, for example, page 23, lines 23-24.

No new matter has been added and entry of the Amendment is respectfully requested. Upon entry of the Amendment, claims 1-7, 9 and 11 will be all the claims pending in the application.

Applicants appreciate the Examiner's participation in the Interview conducted on July 18, 2006. Statement of Substance of Interview is incorporated herein.

**I. Form PTO/SB/08 A & B**

The Examiner attaches to the Office Action, a signed copy of the Form PTO/SB/08 A & B filed with the application on July 20, 2005. However, the Examiner does not initial the JP and WO documents listed under "Foreign Patent Documents," without any detailed explanation.

Applicants submit that all the omitted references were submitted on CD-ROM on July 20, 2005. In addition, the degree of relevance of these references was indicated in the International Search Report, a copy of which was also submitted on July 20, 2005. Moreover, Applicants

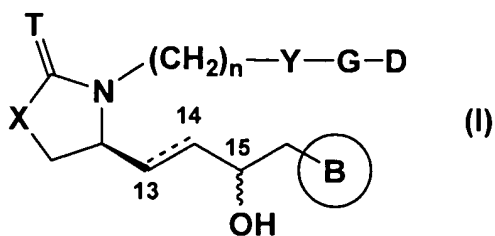
provided the concise explanation regarding foreign language documents in Applicants' Information Disclosure Statement filed July 20, 2005. Therefore, Applicants respectfully submit that the submission of all of the cited documents is in compliance with the rules and should be considered.

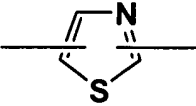
Accordingly, the Examiner is respectfully requested to consider all the cited references and return a signed copy of Form PTO/SB/08 A & B with the next PTO communication.

## II. Election/Restrictions

The Examiner acknowledges Applicants' election of Group I, claims 1-8 and the species of Example 15(11). Further, the Examiner indicates that rejoinder of method of use claims (claim 9) commensurate in scope with the product claims (claims 1-8) will occur when the product claims are found allowable.

In addition, the Examiner defines the scope of the elected subject matter ("genus") as the compounds of formula (I):

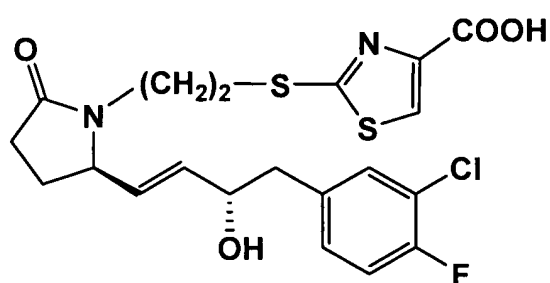


wherein D is  $-\text{COOR}^1$ ,  $\text{R}^1$  is hydrogen or C1-4 alkyl, G is , Y is a single bond or  $-\text{S}-$ , T is oxygen or sulfur, X is  $-\text{CH}_2-$ , ringB is C3-7 cycloalkyl optionally substituted,

and q and n are defined in claim 1. The Examiner also indicates that claims 1 (in part), 3-6 (in part) and 7-8 are currently under examination.

The Examiner appears to make an inadvertent error in describing “ringB” in the above-defined elected invention.

Specifically, Applicants elected species, Example 15(11):



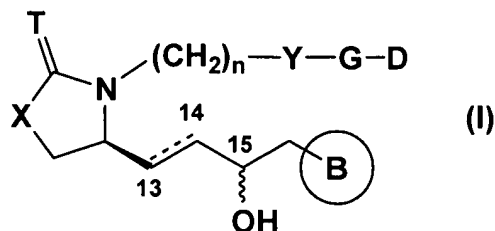
In Example 15(11), the portion corresponding to ringB of formula (I) is a chloro- and fluoro-substituted phenyl group. Thus, the genus as defined by the Examiner, wherein ringB is C3-7 cycloalkyl optionally substituted, would not include the elected species.

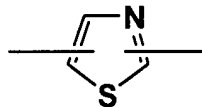
Further, q would not be necessary because it is not present in the genus as defined by the Examiner.

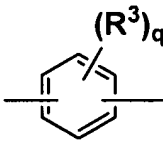
Moreover, claims 5 and 6 are indicated to fall within the genus. The portion in formula (I-2) recited in claim 5, which corresponds to ringB of formula (I), and in the compounds of claim 6 is an unsubstituted or substituted phenyl group.

Still further, the Examiner relies on Example 3(B) of Cameron et al in the rejections of the present Office Action. Applicants note that Example 3(B) of Cameron et al contains a chloro-substituted phenyl group.

During the Interview of July 18, 2006, the Examiner admitted the inadvertent error in the definition of “ringB” and confirmed that the genus should have been defined as the compounds of formula (I):



wherein D is  $-\text{COOR}^1$ ,  $\text{R}^1$  is hydrogen or C1-4 alkyl, G is , Y is a single

bond or  $-\text{S}-$ , T is oxygen or sulfur, X is  $-\text{CH}_2-$ , ringB is , and  $\text{R}^3$ , q and n are defined in claim 1.

### III. Response to Objection to Specification

The specification is objected to. Specifically, the Examiner asserts that the first paragraph of the specification does not contain continuing data from which the present application claims benefit.

Applicants respectfully traverse the objection. The present application is a 371 national stage application of a PCT application. MPEP § 1893.03(c)(III) states that “it is not necessary for the applicant to amend the first sentence of the specification to reference the international

application number that was used to identify the application during international processing of the application by the international authorities prior to commencement of the national stage.”

Nonetheless, to facilitate the prosecution, Applicants have in the Amendment, amended the specification, as suggested by the Examiner.

Accordingly, the Examiner is respectfully requested to reconsider and withdraw the objection to the specification.

**IV. Response to Objection to Claim**

Claim 8 is objected to as being of improper dependent form.

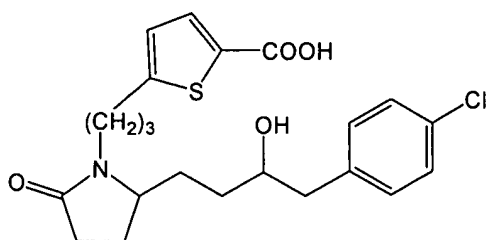
Applicants submit that this objection is moot because claim 8 has been canceled.

**V. Response to Rejection under 35 U.S.C. § 102**

Claim 1 is rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Cameron et al (US 2002/0065308 and U.S. Patent 6,552,067).

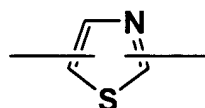
Applicants respectfully submit that claim 1 is novel over Cameron et al for the following reasons.

Cameron et al describes in Example 3B, which is relied upon by the Examiner, 5-(3-{2S-[4-(4-chloro-phenyl)-3-hydroxy-butyl]-5-oxo-pyrrolidin-1-yl)-propyl)-thiophene-2-carboxylic acid (col. 60, lines 10-14). Applicants submit that this compound has the following structure, which is different from that provided by the Examiner:

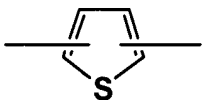


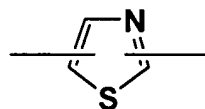
Example 3B of Cameron et al

This compound of Cameron et al does not meet the requirements of formula (I) recited in the present claims. In particular, in present formula (I) as defined by the Examiner, G is



. On the other hand, in the compound of Example 3B of Cameron et al, the group

corresponding to G in present formula (I) is , which is different from



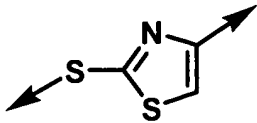
In view of the foregoing, Applicants respectfully submit that present claim 1 is not anticipated by Cameron et al, and thus the rejection should be withdrawn.

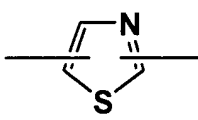
#### VI. Response to Rejection under 35 U.S.C. § 103

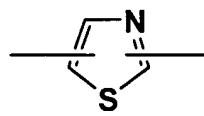
Claims 5 and 6 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Cameron et al.

Applicants respectfully traverse the rejection for the following reasons.

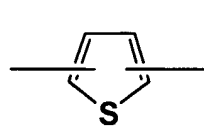
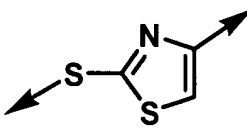
The Examiner appears to mischaracterize the instant formula (I-2) recited in present

claim 5. Specifically, in the instant formula (I-2), G<sup>2</sup> is , (or with respect to

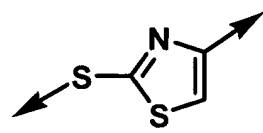
formula (I) recited in present claim 1, G is  and Y is S), rather than

, contrary to the Examiner's characterization.

On the other hand, in Example 3B of Cameron et al, which is relied upon by the Examiner, the group corresponding to G<sup>2</sup> in present formula (I-2) is thiophene, i.e.,

, which is different from  of the present invention.

Furthermore, in general Formula (I) of Cameron et al, X is -CH<sub>2</sub>- or O, and Z is -(CH<sub>2</sub>)<sub>n</sub>-, thienyl, thiazolyl or phenyl. That is, general Formula (I) of Cameron et al does not include a

compound containing the  moiety.

Therefore, Applicants submit that one of ordinary skill in the art would not have been motivated to substitute -(CH<sub>2</sub>)<sub>2</sub>-S- for -(CH<sub>2</sub>)<sub>3</sub>- (when X is -(CH<sub>2</sub>)-) or -(CH<sub>2</sub>)<sub>2</sub>-O- (when X is O) in Formula (I) of Cameron et al. Furthermore, there would not have been a reasonable expectation that the so-modified compound would be an EP4 receptor selective prostaglandin agonist.

In view of the foregoing, Applicants respectfully submit that the present claims are not obvious over Cameron et al, and thus the rejection should be withdrawn.

**VII. Response to Provisional Double Patenting Rejection**

Claims 1 and 3-6 are provisionally rejected on the ground of non-statutory obviousness-type double patenting as allegedly being unpatentable over claims 1-13 of Maruyama et al (US 2005/0020686) in view of Cameron et al.

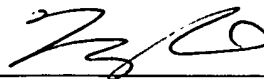
In response, Applicants submit herewith a Terminal Disclaimer. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the provisional double patenting rejection.

**VIII. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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**23373**

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